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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/858,360	05/16/2001	Joseph A. Manico	82171SLP	3327

7590 10/18/2006
Thomas H. Close
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EXAMINER

BAKER, CHARLOTTE M

ART UNIT PAPER NUMBER

2625

DATE MAILED: 10/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/858,360

Applicant(s)

MANICO ET AL.

Examiner

Charlotte M. Baker

Art Unit

2625

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED _____ FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Attached. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1, 3-14 and 16-38.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

With regard to Applicant's argument that the Office Action mailed on September 6, 2006 is an improper final rejection, Examiner respectfully traverses. Attention is drawn to MPEP §706.07(b) [R-1].

706.07(b) [R-1] Final Rejection, When Proper on First Action

The claims of a new application may be finally rejected in the first Office action in those situations where (A) the new application is a continuing application of, or a substitute for, an earlier application, and (B) all claims of the new application (1) are drawn to the same invention claimed in the earlier application, and (2) would have been properly finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application.

> A first Office action in a continuing or substitute application may not be made final if it contains a new ground of rejection necessitated by the amendments to 35 U.S.C. 102(e) by the Intellectual Property and High Technology Technical Amendments of 2002 (Pub. L. 107-273, 116 Stat. 1758 (2002)).<

However, it would not be proper to make final a first Office action in a continuing or substitute application where that application contains material which was presented in the earlier application after final rejection or closing of prosecution but was denied entry because (A) new issues were raised that required further consideration and/or search, or (B) the issue of new matter was raised.

Further, it would not be proper to make final a first Office action in a continuation-in-part application where any claim includes subject matter not present in the earlier application. A request for an interview prior to first action on a continuing or substitute application should ordinarily be granted.

A first action final rejection should be made by using Form Paragraphs 7.41 or 7.41.03, as appropriate.

It is clear that the Examiner did not make an improper final rejection and by Applicant's own admission, Examiner did not violate the guidelines for making a final rejection on a first action as outlined in MPEP §706.07(b) [R-1]. Applicant chose to submit an RCE instead of an after-final amendment based on an assumption of what the Examiner might do in the after-final amendment scenario. Examiner appreciates that Applicant was trying to save Examiner rework. Examiner respectfully traverses Applicant's arguments that Applicant is somehow being penalized for attempting to

reduce the Examiner's amount of rework. The final rejection on first action following the RCE was proper and was not meant to penalize Applicant. Examiner maintained the same art in the final rejection (09/06/2006).

Regarding Applicant's remarks that Examiner did not comment on the features that were added to the claims submitted on (08/09/2006), Examiner respectfully traverses. Attention is drawn to the Office Action (09/06/2006) on p. 2 (regarding that Vallmajo et al. was not relied upon for those teachings) and in the body of the Office Action (p. 4, p. 5) where the new claim language is incorporated into the rejections of the claims.

Regarding Applicant's arguments that a first action Final Rejection is premature because the claims require a different feature than the claims examined before the RCE, raising new issues for search and consideration, Examiner respectfully traverses. Attention is drawn to MPEP §706.07(b) [R-1]; therefore, the first action Final Rejection is proper and will not be withdrawn.

Regarding Applicant's argument that Examiner's Office Action is deficient for not addressing Applicant's argument at p. 8 of the Preliminary Amendment (09/07/2006), Examiner respectfully traverses. Applicant stated the following:

Independent claims 1, 14, 26, and 32 are herein amended to indicate that a user inputs at least one image into one of the plurality of network connected kiosks, and selects one or more image bearing product for at least one image. The identifier is generated for the image bearing product(s) selected, and is used to retrieve the associated image and generate the selected image bearing product(s) using the image.

This is a statement of the claim limitations that have been added to claims 1, 14, 26 and 32, which Examiner gives weight to in the body of the Office Action (see rejection of claims 1, 14, 26 and 32). There was no argument provided on p. 8 of Preliminary Amendment (08/07/2006) regarding the addition of the claim limitations in claims 1, 14, 26 and 32. Examiner did provide an appropriate response in the body of the Office Action (see rejection of claims 1, 14, 26 and 32).

Examiner did not place Vallmajo et al. on p.2, last par. for (Fig. 1A and 1B, printer device 20 and col. 4, ln. 52-57). It is clear in the body of the Office Action that it is Vallmajo et al. that contains these items. This is a typographical error, and not a deficiency in the Office Action, nor is it grounds for revoking the finality of the previous Office Action.

Regarding Applicant's argument that there is no mention of associating an identifier with an image bearing product, Examiner respectfully traverses. It is the combination of Vallmajo et al. in view of Meyer et al. that satisfies this limitation (see rejection of claim 1 in the Office Action).

Regarding Applicant's arguments that Meyer et al. do not disclose an identifier that is associated with an image bearing product, Meyer et al. was not relied upon for the teaching of the image bearing product. Meyer et al. was relied upon for the identifier. It is the combination of Vallmajo et al. and Meyer et al. that satisfy the claim limitations.

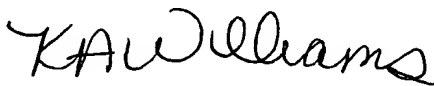
Regarding Applicant's arguments regarding Redd et al. that the reference does not cure the deficiencies of Vallmajo et al. and Meyer et al., Redd et al. was not relied upon

for the teaching of associating an identifier with an image bearing product, or generating an image bearing product using the identifier.

Regarding Applicant's arguments regarding Liebenow that the reference does not cure the deficiencies of Vallmajo et al. and Meyer et al., Liebenow was not relied upon for the teaching of associating an identifier with an image bearing product, or generating an image bearing product using the identifier.

In conclusion, the combination of Vallmajo et al., Meyer et al., Redd et al. and Liebenow disclose the claimed invention.

In view of the most recent amendments to the claims, further consideration and/or search is required because the claims are now broader than in previous amendments.


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